

III. Claims 54-56, drawn to methods of use, classified in class 514, subclass 374+.

The Office Action indicates that Groups I and II are distinct because the process as claimed can be used to make other materially different products. The Office Action also indicates that Groups I and III are distinct because the process for using the product as claimed can be practiced with another materially different product. According to the Examiner, the inventions have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group III, and therefore it would impose an undue burden on the Examiner and the Patent Office's resources to examine the instant application if unrestricted. In addition, the Examiner is requiring the Applicant to elect a single disclosed species from whichever group is ultimately elected.

The Applicants hereby provisionally elect with traverse Group I drawn to compounds of claims 1-50, 52, and 53 for prosecution on the merits. Applicants also provisionally elect with traverse the species [rac]-3-{4-[2-(2-tert-Butyl-5-methyl-oxazol-4-yl)-ethoxy]-2-methyl-phenyl}-2-ethoxy-propionic acid of Example 47 and claim 50 if no generic claim is held allowable.

The Applicants traverse the restriction requirement and respectfully submit that the requirement is improper for the following reasons.

There is no serious burden to search and examine Groups I and II together, because Groups I and II are classified in the exact same class and subclass ("class 548, subclass 215+"). Since the Examiner would be searching the exact same class and subclass for Groups I and II, it is respectfully submitted that no serious burden would be imposed by examining Groups I and II together. If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits (MPEP § 803).

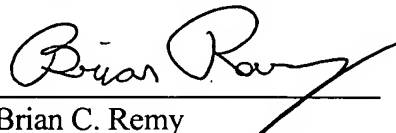
Application No.: 10/700,417
Filed: November 4, 2003

In addition, Claim 51 (Group II) is specifically directed to the manufacture of compounds according to claim 1 (Group I). Accordingly, the process of manufacture (claim 51, Group II) does not cover the manufacture of materially different products (different from the products recited in claim 1 or Group I), as the Examiner suggests. Similarly, the methods of using the products (claims 54-56, Group III) are directed to methods of treatment using the same products that are recited in claim 1 or Group I. Consequently the method of use (claims 54-56, Group III) does not cover the use of another materially different product (other than those products of Group I), as the Examiner suggests.

Additionally, because the issues related to search and examination are the same or closely related for each of the groups, the Applicants submit that no serious burden would be imposed by examining all the Groups together. Moreover, all of the species recited in the claims are linked by at least one genus claim and the number of species is reasonable. The Applicants respectfully note that if a linking claim is allowed the examiner is required to examine the species linked by the generic linking claim in accordance with MPEP § 809.04.

In accordance with the reasoning set forth above, the Applicants kindly request reconsideration and withdrawal of the restriction requirement and examination of the application in its entirety. No fees are believed due with the filing of this response; however, the Director is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No. 08-2525.

Respectfully submitted,



Brian C. Remy
Attorney for Applicant(s)
(Reg. No. 48,176)
340 Kingsland Street
Nutley, New Jersey 07110
Telephone: (973) 235-6516
Telefax: (973) 235-2363

149356v2